

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP
Jean-Francois Estur et al.)	
Application No.: 10/562,047)	Group Art Unit: 1794
Filed: August 8, 2006)	Examiner: VICTOR S CHANG
For: PRODUCTION OF PEARLS BASED)	Confirmation No.: 6151
ON EXPANDED POLYMERS)	
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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Requirement for Election issued December 31, 2007, Applicants hereby elect with traverse, the invention of Group I, Claims 15-25 and 29-35, directed to a process for preparing a pearl.

For at least the reasons that follow, Applicants respectfully request reconsideration and withdrawal of the Requirement.

According to M.P.E.P. § 1893.03(d):

[W]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group. [emphasis added.]

Although the Requirement lists different groups of Claims on page 2, the Requirement does not appear to explain why each group lacks unity with each other group, as required by § 1893.03(d). Thus, the Restriction Requirement does not appear to meet the burden of establishing a lack of unity of invention because it fails

to explain why each group lacks unity with each other group or specifically describe each group's unique technical features. Accordingly, Applicants submit that the Requirement should be withdrawn for at least these reasons.

In addition, as set forth in M.P.E.P § 1850:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. [emphasis added.]

For example, Claim 37 of Group II depends directly from independent Claim 15 of Group I. Therefore, Claim 37 includes each of the features of Claim 15. Furthermore, the Restriction Requirement has not made the requisite showing of why the claims lack unity of invention. In this regard, the Requirement takes the position that the claims lack unity of invention:

. . . because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: claim 26 is either anticipated by or obvious over EP 0 450 205 [page 4, line 25 - line 30; example 2]. Claim 26 lacks novelty or inventive step, and does not make a contribution over the prior art. (See Official Action at page 2.)

This reasoning is not understood, and does not appear to comport with 37 C.F.R. § 1.475(b), which states that:

An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product.

Applicants submit that the above-quoted section prevents restriction of claims directed to certain combinations of invention categories. Because the present set of claims includes combinations that fall within § 1.475(b), the claims should be considered to have unity of invention. (See also M.P.E.P. § 1850.)

Accordingly, for the at least the above reasons, the Requirement for Restriction is improper and should be withdrawn.

For at least the above reasons, and in order to avoid unnecessary delay and expense to Applicants, and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

If there are any questions concerning this Response or the application in general, Applicants invite the Examiner to telephone the undersigned at the below-listed number.

Respectfully submitted,

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Date: February 8, 2008

By:



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